

REMARKS

In the Office action mailed on March 2, 2004, claims 1-16, 25 and 26 were rejected under 35 U.S.C. 102(e) as being anticipated by either U.S. Patent No. 6,451,026 ("Biagtan") or U.S. Patent No. 6,612,998 ("Gosiengfiao"). Claims 17-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over either Biagtan in view of U.S. Patent No. 5,951,494 ("Wang"), or Gosiengfiao in view of Wang.

By the present amendment, claims 25 and 26 have been amended to clarify the claim language, and claims 27-39 have been added. Claims 1-39 remain pending and under consideration in the present application. Applicant respectfully requests reconsideration of the claims in view of the remarks presented below.

Section 102(e) Rejection Based on Biagtan

The Office action rejected claims 1-16, 25 and 26 under 35 U.S.C. 102(e) as being anticipated by Biagtan. Applicant respectfully disagrees.

Biagtan discloses an elongate member 11 made of a fiber composite matrix and an optional core member 17 disposed within a core lumen 18 of the elongate member 11. *See* col. 4, lines 39-64 of Biagtan. The Office action did not identify any structure in Biagtan as corresponding to the non-conductive connecting element of independent claim 1. Applicant respectfully submits that Biagtan does not disclose the claimed "non-conductive connecting element securing together a distal end of the proximal core section and a proximal end of the distal core section."

In addition, Biagtan does not disclose that the ends of the core sections have the claimed "undulating shape to effect a mechanical interlock with the non-conductive connecting element" as set forth in dependent claim 2. Biagtan also does not disclose

that the coil should have "a volumetric magnetic susceptibility enabling observation ... when subjected to MRI" as recited in claim 3, or the specific volumetric magnetic susceptibilities recited in claims 4 and 5. Applicant notes that Biagtan is concerned with avoiding imaging artifacts. *See* col. 3, lines 24-29 ("A distal section configured to not create imaging artifacts with MRI imaging ..."). Biagtan also does not disclose that the distal core section should be less than a certain length based on the MRI field strength. *See, e.g.*, claims 8 and 9. The specification of the present application teaches that controlling the length of a metallic section can avoid undesirable heating when the device is subjected to the magnetic fields generated by the MRI. *See* page 10, lines 1-19 of the specification. Applicant disagrees with the suggestion in the Office action that such limitations are inherently taught by the disclosures of either Biagtan or Gosiengfiao.

With respect to method claims 25 and 26, Applicant respectfully submits that Biagtan does not disclose the claimed step of advancing the claimed guide wire under MRI until the MRI visible marker on the distal core section is disposed within a desirable location within the patient. Biagtan discloses that the core member 17 and the coil 30 can be made from non-metal materials to avoid creating imaging artifacts with MRI. *See, e.g.*, col. 3, lines 24-29 ("A distal section configured to not create imaging artifacts with MRI imaging, or other sensitive imaging methods ..."), and col. 6, lines 12-18 and 48-56. Biagtan does not appear to disclose the use of an MRI visible marker on a distal section for placement of a guide wire under MRI. Applicant respectfully requests that the Section 102(e) rejection of claims 1-16, 25 and 26 based on Biagtan be withdrawn.

Section 102(e) Rejection Based on Gosengfiao

The Office action rejected claims 1-16, 25 and 26 under 35 U.S.C. 102(e) as being anticipated by Gosiengfiao. Applicant respectfully submits that Gosiengfiao does not disclose the claimed "electrically non-conductive proximal core section," or the claimed

"non-conductive connecting element securing together a distal end of the proximal core section and a proximal end of the distal core section." *See, e.g.*, claim 1.

While Gosiengfiao discloses "an elongated proximal shaft section 12" and "a distal shaft section 13," Gosiengfiao does not disclose whether the proximal shaft section 12 is "non-conductive" as required by the claimed invention. *See* col. 4, lines 31-62. Moreover, there appears to be no disclosure in Gosiengfiao of a non-conductive connecting element securing the proximal core section to the distal core section. Indeed, the Office action did not identify any structure in Gosiengfiao as corresponding to the non-conductive connecting element of independent claim 1.

Applicant respectfully requests that the Section 102(e) rejections of claims 1-16, 25 and 26 based on Biagtan and on Gosiengfiao be withdrawn.

Section 103(c)

Claims 17-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over either Biagtan in view of Wang, or Gosiengfiao in view of Wang. Applicant respectfully requests that these rejections be withdrawn in accordance with 35 U.S.C. 103(c).

The present application and the Gosiengfiao and Biagtan patents were, at the time the invention was made, subject to an obligation of assignment to the same entity, Advanced Cardiovascular Systems, Inc. Under 35 U.S.C. §103(c), subject matter which qualifies as prior art only under §102(e) "shall not preclude patentability under this section where the subject matter and the claimed invention were ... subject to an obligation of assignment to the same person." *See also* 706.02(l). Since the Gosiengfiao patent, the Biagtan patent, and the present application were all subject to an obligation of assignment to the same entity at the time the invention was made, neither the Gosiengfiao patent nor the Biagtan patent can form the basis of an obviousness rejection.

Accordingly, Applicant respectfully that the Section 103 rejections of claims 17-24 based on Gosiengfiao and Biagtan be withdrawn in accordance with 35 U.S.C. §103(c).

New Claims

New claims 27-39 have been added to further define the invention. No new matter has been added. For example, support for new claim 32 can be found at page 10, lines 14-17 of the specification.

CONCLUSION

Applicant respectfully requests favorable reconsideration of the claims at an early date. If the Examiner has any comments or questions regarding any of the foregoing, kindly telephone the undersigned.

Respectfully submitted,

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